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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 15

Application Number: 08/861,231
Filing Date: 5/21/97
Appellant(s): Heikki Ilvespaa

Chi K. Eng
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 10/22/99.

Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

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Status of Claims

This appeal involves claims 26, 28-34 and 36-41.

Claims 1-25 are allowed.

Status of Amendments After Final

No amendment after final has been filed.

Summary of Invention

The summary of invention contained in the brief is correct.

Issues

The appellant's statement of the issues in the brief is correct.

Grouping of Claims

The rejection of claims stand or fall together.

Claims Appealed

Claims 32 and 39 contain substantial errors as presented in the Appendix to the brief.

Claim 32 is missing, in its entirety; and claim 39 includes language which was deleted in the Applicant's Amendment A, paper #7. The claims are correctly stated in the Appendix of the Examiner's Answer.

Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

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Claims 26, 28-34 and 36-41 are rejected under 35 U.S.C. 351. This rejection is set forth in prior Office action, Paper No. 12.

Response to Argument

Applicant has broadened the patent claims in a manner directly pertinent to the subject matter that applicant surrendered during the prosecution; hence, under In re Clement, 45 USPQ 2d 1161 (Fed Cir. 1997), that is precluded by the equitable recapture doctrine. The narrowing that has occurred, in the reissue claims, has not been demonstrated to relate to the prior art rejections with respect to which the removed limitations were added to get the patent claims in condition for allowance. This narrowing is not a material narrowing in the sense that the narrowing limitation is material to the rejections which gave rise to the limitations, now removed from certain reissue claims, being added to overcome the rejections.

The principles of the recapture rule applied in Hester Industries, Inc. v. Stein Inc., 46 USPQ 2d 1641 (Fed. Court 1998) are considered to be applicable to the facts of the present application in that the reissue claims presented by Applicant contain limitations which are not materially narrower than those of the original claims of the parent application; thus, the recapture rule cannot be avoided. Applicant broadens the original claimed material limitation of "steam" to "moisture and heat." This is novel in the treatment of the processing of the paper web. The limitations that applicant suggests are narrowed material limitations that were overlooked in the original patent prosecution are merely recitations of typical dryer structure for paper webs, including the arrangement of cylinders, guide rolls, wires and web. These

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features are old and well known structure of dryer groups and are not deemed to be material limitations.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Pamela A. Wilson

Pamela A. Wilson: paw
February 11, 2000

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APPENDIX

Claims 32 and 39 contain substantial errors as presented in the Appendix to the brief.

Claims 32 and 39 are correctly stated, as follows:

Claim 32

The method of claim 26, wherein said stresses in the paper web are formed at a solids content of at least about 70%.

Claim 39

The paper machine of claim 34, wherein said stresses in the paper web are formed at a solids content of at least about 70%.